

REMARKS

A Petition for Extension of Time has been concurrently filed with this response. Thus, this response is being timely filed.

Applicant respectfully requests the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims

In the present Reply, claim 1 has been amended. Also, claims 2, 3, 6, 10, 13, 14 and 17-21 were canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 1, 4, 5, 7, 8, 9, 11, 12, 15 and 16 are pending in the present application.

No new matter has been added by way of the amendment to claim 1. The amendment is for clarification purposes and does not change the meaning thereof. By deleting/amending these terms in order to clarify the claimed invention, Applicant in no way is conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

Claim Objections

Claims 1, 4, 5, 7-9, 11, 12, 15 and 16 stand objected to due to the recitation of the word "of" in line 8 of claim 1. Applicant respectfully traverses.

Applicant respectfully refers the Examiner to claim 1 as presented herein. It is believed that this clarifying amendment overcomes this objection. Withdrawal of the objection is respectfully requested.

Issues under 35 U.S.C. § 103(a)

Claims 1, 4, 5, 7-9, 11 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas '806 (U.S. Patent No. 5,553,806) in view of Harkins '462 (U.S. Patent No. 2,353,462) (see pages 2-4 of the Office Action).

Also, claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas '806 in view of Harkins '462 as applied to claims 1 and 11 above, and further in view of Perrigo '373 (U.S. Patent 5,035,373) (see page 4 of the Office Action). Claim 12 ultimately depends on claim 1.

Applicant respectfully traverses, and reconsideration and withdrawal of these rejections are respectfully requested.

Previously, Applicant referred the Examiner to the claimed feature of "said lay-on roll has a radius that is the same of the entire length thereof" in pending claim 1. Further, in the Amendment dated September 11, 2006, Applicant stated the following:

Applicants note that the cited primary reference of Lucas '806 has a groove pattern on its peripheral surface thereof (see its Figures 1 and 11). Figure 11 of Lucas '806 is the cross-sectional view through section "C" of Figure 10 that shows the profile of some of the recessed holes in the cover (see column 3, lines 63-65). In contrast, the present invention has a flat peripheral surface over the entire length of the rotatable lay-on roll. Such a feature of the present invention also produces an advantageous effect such that electrostatic charge is suppressed across the full width of the polymer film when used. When in use, the instantly claimed film winding method provides the manufacture of a polymer film of high

quality with improved, high reliability in production (as described in the present specification at, e.g., page 3, lines 11-17). On the other hand, the cited combinations of references fail to disclose the instantly claimed rotatable lay-on roll having the flat peripheral surface, as well as lacking any disclosure of the advantage of suppression of electrostatic charge to such an embodiment.

However, in the current Office Action at page 5, the Examiner states that these arguments are not persuasive. In particular, the Examiner states, *inter alia*, that the rollers of **12, 14, 15** of Lucas '806 have the claimed cylindrical shape (see Office Action at page 5, lines 5-6); and that the roller surface hardness and electrical resistivity are independent features with independent effects. Applicant wishes to emphasize the following points.

Applicant respectfully submits that it is clear that the Lucas '806 roller does not have a radius that is constant across the entire length of the roller. In particular, Applicant refers to Figures 7 and 12. Further, the secondary reference of Harkins '462 does not disclose this claimed feature. Applicant notes that a *prima facie* case of obviousness requires disclosure of all claimed features, *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), and that requirement has not been satisfied here for either § 103(a) rejection.

As stated in the Office Action at page 3, lines 4-8, lines 11-13 and lines 14-17, the Examiner is essentially taking the surface material of Harkins '462 (having the specified electrical resistivity of 20,000 Ω cm) and inserting into the Lucas '806 rollers **12, 14** and **15**. But such a proposed combination still does not account for the claimed feature of a roller having a constant radius the entire length thereof.

When Applicant previously argued that the asserted combination of disclosures is improper, the Examiner stated that the roller surface hardness and volume resistivity are independent features with independent effects. Applicant agrees in that the roller surface

hardness and volume resistivity do not have a relationship with each other. But this also means that each feature independently has the effect of preventing the generation of static electricity. In the present invention, electrostatic charge is suppressed across the full width of the polymer film when used. When in use, the instantly claimed film winding method provides the manufacture of a polymer film of high quality with improved, high reliability in production (as described in the present specification at, e.g., page 3, lines 11-17). Further, regarding the comments in the Office Action at page 5, lines 10-17, Applicant notes that the asserted combinations of references still fail to disclose the claimed feature of a roller having a constant radius over the entire length thereof (which leads to the effects described above).

Finally, Applicant respectfully traverses the conclusion drawn in the Office Action at page 4, lines 5-8 regarding pending claims 7, 11 and 16. No evidence has been submitted to show the claimed features are a matter of "obvious engineering choice."

In view of the above comments, Applicant believes the pending application is in condition for allowance.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Application No. 10/665,497
Art Unit 3654
Reply to Office Action of January 4, 2007

Docket No.: 1259-0237P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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